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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,060	01/14/2002	Anand Baichwal	540.1004CON2	3558
23483	7590	10/06/2004	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109			AZPURU, CARLOS A	
			ART UNIT	PAPER NUMBER

1615

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/047,060  
Filing Date: January 14, 2002  
Appellant(s): BAICHWAL ET AL.

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Emily Whelan  
For Appellant

Supplemental  
**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 04/14/2004.

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In response to applicant's arguments concerning the rejection under 35 USC 112, second paragraph, applicant again misstates the purpose of the rejection. The question is not whether the claims are clear. This would entail a first paragraph issue under 35 USC 112. The question here is whether the claims as written would allow the ordinary practitioner to particularly point out the invention above any defined by the prior art. Applicant is seeking to define a device by the composition contained within it. The additional question asked here should be, if the composition were to be contained in another device having an actuator, chamber and output port, would THAT device also be patentable due to the included composition? Further, is there anything about the three device limitations which would tell the ordinary practitioner that only this device may house the claimed composition? Do any of the limitations have specific dimensions, actions or purpose which would exclude any other composition? The answer to each question is clearly no. These claims lack any means plus function language which would support considering them as kit claims. Instead, they are device claims which happen to have a composition within the device, but do not seem to be limited in any way to the specifics of that composition. While recognizing that applicant is his or her own lexicographer, applicant can not set out claims which are clearly indefinite as to how they distinguish over the prior art devices.

Regarding the three rejections under 35 USC 102(b), each and every limitation of the device claim is cited by the prior art. These limitations are: an


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actuator, a chamber and an output port. These are the only device limitations set out by the applicant. There is no means plus function language which would tell the ordinary practitioner that only this device is capable of housing the composition of the claims. Applicant has already been granted a patent on the composition. There is nothing patentable about device claims having the instant limitations. Further, if the composition can only be held in the claimed device, why are there no limitations or wording which would make this apparent. Instead, applicant has chose to maintain device limitations which would can read on any number of prior art devices by only setting out three general limitations with no indication that that they are limited in purpose to the instant composition.

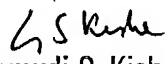
For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

  
Carlos Azpuru  
October 4, 2004  
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